

GP 1632

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 18 2000

In re Application of

Shiuan CHEN et al.

Serial No. 09/552,705

Filed: 19 April 2000



Examiner: P. Brunovskis

Group Art Unit: 1632

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For: Drug Screening Using a Proline-Rich
Nuclear Receptor Co-Regulatory
Protein/Nuclear Receptor
Co-Expression System

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed 8 November 2000 subjecting the claims to a restriction requirement and an election of species, Applicants elect the following with traverse. Applicants elect the claims of Group IV (claims 43-52). The Office Action further required an election of species for 1) a co-regulatory protein, 2) a nuclear receptor or nuclear receptor binding domain and 3) a ligand or hormone. Applicants elect 1) PNRC as the co-regulatory protein, 2) the estrogen receptor, and 3) estradiol.

REMARKS

The Office Action has divided the claims into four groups. All of the groups are classified within class 435, subclass 29. The Office Action admits that there are no provisions within M.P.E.P. § 806.05 for inventive groups that are directed to different methods. The Office Action asserts that restriction is deemed to be proper between the methods of groups I-IV because these methods constitute patentably distinct inventions requiring different goals, methodologies, products, and technical considerations. This assertion is not supported by any explanation within the Office Action. First, no explanation is set forth explaining why, despite the lack of provisions within M.P.E.P. § 806.05, a restriction requirement can be imposed. Second, no explanation is set forth